

In re Appln. of Verschueren et al.  
Application No. 10/068,312

## REMARKS

Reconsideration of the above-identified application is respectfully requested in view of the foregoing amendments and the following remarks.

### *The Pending Claims*

Claims 1-15 are currently pending. Claims 1-15 are directed to methods of lithographic printing. Each claim comprises at least the steps of: (i) unwinding a web of a flexible lithographic base from a supply spool, the lithographic base having a hydrophilic surface; (ii) wrapping the lithographic base around a cylinder of a printing press; (iii) applying on the lithographic base an image-recording layer which is removable in a single-fluid ink or can be rendered removable in a single-fluid ink by exposure to heat or light; (iv) image-wise exposing the image-recording layer to heat or light; (v) processing the image-recording layer by supplying single-fluid ink, thereby obtaining a printing master; (vi) printing by supplying single-fluid ink to the printing master which is mounted on a plate cylinder of the printing press; and (vii) removing the printing master from the plate cylinder.

### *The Amendments to the Specification*

The Office Action noted a grammatical error in paragraph [0018]. This error is corrected by an amendment to the specification. Specifically, in the revised paragraph, "consists" is replaced by "consist". No new matter is added by way of this amendment.

### *Summary of the Office Action*

Claims 1, 2, and 6-8, stand rejected under 35 U.S.C. § 103(a) as obvious over Teng et al. (i.e., U.S. Patent 6,482,571) in view of Bailey et al. (i.e., U.S. Patent 6,040,115) and Moss et al. (i.e., EP 640,479). Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as obvious over Teng et al. in view of Bailey et al., Moss et al., and a European patent to Vermeersch et al. (i.e., EP 770, 494). Claim 5 stands rejected under 35 U.S.C. § 103(a) as obvious over Teng et al. in view of Bailey et al., Moss et al., and a U.S. patent to Vermeersch et al. (i.e., U.S. Patent 5,786,128). Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as obvious over Teng et al. in view of Bailey et al., Moss et al., and Klingman et al. (i.e., U.S. Patent 6,140,392).

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*Discussion of the Obviousness Rejections*

(a) Claims 1, 2 and 6-8

The inventive methods, as set forth in claims 1, 2 and 6-8, provide a novel approach to lithographic printing. Each method requires unwinding a web of flexible lithographic base from a supply spool, wrapping the base around a printing press cylinder, applying an image-recording layer onto the base (the layer being removable or able to be rendered removable by a single-fluid ink), image-wise exposing the image recording layer, processing the exposed layer by supplying single-fluid ink (and thereby creating a printing master), printing while the printing master is mounted on a plate cylinder of the printing press, and removing the printing master from the printing press.

The Office Action acknowledges that Teng does not teach several steps in the claimed methods. Specifically, Teng fails to teach the steps of unwinding a lithographic base from a supply spool, wrapping the base around a plate cylinder, applying an image-recording layer onto the base, and removing the printing master from the printing press.

The Office Action overcomes these deficiencies by using Bailey, arguing that Bailey teaches at least one of the steps absent in Teng—the application of an image-recording layer onto a base plate located on the printing press. Moss, the Action continues, teaches the remaining steps missing in Teng—the desirability of unwinding a material from a supply spool, wrapping the material around a plate cylinder, and removing the used material from the plate cylinder by winding it onto an uptake spool.

A reading of Bailey, however, does not support the teaching attributed to Bailey by the Office Action. Bailey fails to teach, *inter alia*, the application of an image-recording layer onto a web of flexible lithographic base material while the material is on the press, and subsequently imaging and processing the layer to form a printing master, printing with the master, and removing the printing master after printing is completed. Instead, and in sharp contrast, Bailey teaches the preparation of an imagable element (a substrate having a thermally sensitive co-polymer applied thereon) wherein the thermally-sensitive co-polymer is either “precoated on a suitable substrate” or “sprayed, painted or coated on a reusable drum, plate or sleeve on press.” (Regarding the former, the use of a precoated substrate by Bailey (and Teng) differs from the claimed method, the latter requiring, *inter alia*, the application of an image-forming layer onto a web of flexible lithographic base while the base is wrapped around the printing press cylinder.) Regarding the latter, Bailey suggests spraying, painting or coating the thermally-sensitive co-polymer onto a “reusable drum, plate or sleeve.” As Bailey itself teaches, however, a

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"reusable drum, plate or sleeve" is completely different from the web of flexible lithographic base material used in the claimed method. Bailey itself segregates the imagable elements (substrate plus thermally-sensitive co-polymer) into several categories, including, among others, printing plates, printing sleeves and printing tapes (including flexible printing webs). In segregating printing tapes (webs) from those elements formed using printing cylinders (drums), plates and sleeves, Bailey without question fails to teach or suggest the application of an image-recording layer onto a web of flexible lithographic base material while the material is mounted on the press. On the contrary, one reading the entirety of the passage at column 17 of Bailey (cited in the Office Action) would understand Bailey as teaching the use of precoated printing tapes (webs), and not the "on press" coating of such webs. If Bailey wanted to teach the on press coating of webs, a reference to "printing tapes" would have been included in the passage of Bailey that refers to the application of the thermally-sensitive co-polymer onto a "reusable drum, plate or sleeve on press." *See Bailey at col. 17, ll. 37-39.* Because Bailey did not do so, however, reaching a conclusion that Bailey teaches the coating of printing tapes "on press" is improper, being based upon hindsight analysis.

Moreover, Bailey teaches that reusable substrates should be coated on press with the thermally sensitive co-polymer. However, there is no indication in Bailey, or any other reference cited in the Office Action, that the web material described in Bailey is reusable. There is thus no basis in Bailey for using any web-based material as a substrate in the on press application of a thermally sensitive co-polymer.

The rejection of claims 1, 2 and 6-8 should be withdrawn on this basis alone.

The addition of Moss does not provide the teaching absent in Teng and Bailey. Moss does not teach the on press application of an imaging-layer onto a substrate material, as required by the claimed methods. On the contrary, one skilled in the art would understand Moss to teach the use of precoated material. The teaching provided by Moss is thus no more material than that provided by Bailey.

Moreover, one skilled in the art would not be motivated to combine Bailey with Teng and Moss. Teng and Moss relate to wet off-set printing. Bailey, on the other hand, is directed to the dry planographic or waterless printing art. Because these methods of printing are divergent, there is no motivation set forth in the references themselves that would justify the combination asserted in the Office Action. The extrapolation of Bailey's suggestion to the present invention can only be done with improper hindsight.

For all of the foregoing reasons, applicants respectfully request withdrawal of the rejection of claims 1, 2 and 6-8.

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(b) Claims 3 and 4

Based upon the reasoning set forth under section (a), applicants also request withdrawal of the rejection of claims 3 and 4.

(c) Claim 5

Based upon the reasoning set forth under section (a), applicants also request withdrawal of the rejection of claim 5.

(d) Claims 9 and 10

Based upon the reasoning set forth under section (a), applicants also request withdrawal of the rejection of claims 9 and 10.

(e) Claims 11-15

Examination of each newly presented claim on the merits is respectfully solicited. Each of dependent claims 11-15 is patentable over the prior art cited in the Office Action. None of the methods described in claims 11-15 are disclosed or taught by the cited prior art, either alone or in combination.

*Conclusion*

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted



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Date: September 3, 2003

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NO. 3049 P. 2, ATENT

Attorney Docket No. 215294

Date: September 3, 2003

In re Application of: VERSCHUEREN et al.

Application No. 10/068,312

Filed: February 5, 2002

For: ON-PRESS COATING AND ON-PRESS PROCESSING OF A LITHOGRAPHIC MATERIAL

Mail Stop Non-Fee Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

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Sir:

Transmitted herewith is a response to an office action in the subject application.

☐ Applicants claim small entity status of this application under 37 CFR 1.27.☒ Petition for Extension of Time☐ Applicants petition for a one-month extension of time under 37 CFR 1.136, the fee for which is \$110.00 (enclosed).☒ Applicants believe that no petition for an extension of time is necessary. However, to the extent that such petition is deemed necessary, Applicants hereby petition for a sufficient extension of time to render the present submission timely. Please charge Deposit Account No. 12-1216 for the appropriate petition fee.☒ No additional claim fee is required.☐ Other:

The claim fee has been calculated as shown below:

The claim fee has been calculated as shown below.

					SMALL ENTITY		OTHER THAN A SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	EXTRA CLAIMS PRESENT	RATE	ADDITIONAL CLAIM FEE	RATE	ADDITIONAL CLAIM FEE
TOTAL	15	MINUS	10	=0	x 9=	\$	x 18=	\$0.00
INDEPENDENT	1	MINUS	1	=0	x 42=	\$	x 84=	\$0.00
<input type="checkbox"/>	FIRST PRESENTATION OF MULTIPLE CLAIM				+ 140=	\$	+ 280=	\$0.00
					TOTAL	\$	TOTAL	\$0.00

☐ Please charge my Deposit Account No. 12-1216 in the amount of \$0.00. A duplicate copy of this sheet is attached.☐ A check in the amount of \$ is attached.☒ The Commissioner is hereby authorized to charge any deficiencies in the following fees associated with this communication or credit any overpayment to Deposit Account No. 12-1216. A duplicate copy of this sheet is attached.☒ Any filing fees under 37 CFR 1.16 for the presentation of extra claims.☒ Any patent application processing fees under 37 CFR 1.17.Respectfully submitted,  
LEYDIG, VOIT & MAYER, LTD.

By

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Amendment or ROA Transmittal (Revised 8/1/03)

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**FROM: CHRISTOPHER T. GRIFFITH**  
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IN RE APPLN. OF	VERSCHUEREN ET AL.
APPLICATION NO.	10/068,312
FILED:	FEBRUARY 5, 2002
FOR:	ON-PRESS COATING AND ON-PRESS PROCESSING OF A LITHOGRAPHIC MATERIAL
GROUP ART UNIT:	2854
EXAMINER:	STEPHEN R. FUNK

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